

APR 30 2007

Remarks

This reply is responsive to the office action dated February 7, 2007. Upon entry of this amendment claims 1-3 and 5 are pending; claims 1 and 5 are amended and claim 4 has been cancelled. No new matter has been added. Reconsideration and allowance are requested.

In the office action, the examiner rejected claims 1-3 and 5 under 35 U.S.C. § 102(b) as anticipated by Great Britain patent reference GB 2257000A to Yamada ("the Yamada reference").

Claims 1 and 5 have been amended to recite, *inter alia*:

" . . . means for displaying provisionally selected text data . . . said text data corresponding to said game image displayed with said language selection picture, and for displaying said text data corresponding to said provisionally selected language switched from one of said game image which has been displayed on said background of said language selection picture . . . "

The Yamada reference does not anticipate claim 1 or 5 because it fails to disclose every limitation of those claims.

In the first instance, the Yamada reference fails to disclose "means for displaying provisionally selected text data . . . said text data corresponding to said game image displayed with said language selection picture . . .," as required by claims 1 and 5. (emphasis added) The text data in Yamada's on-screen display does not "correspond" to the image on Yamada's television display. Rather, it corresponds to the commands (e.g., volume) located *within* the on-screen display. (See the Yamada reference, pg. 10, lines 21-23.) In the claimed device, the text data positively corresponds to the game image by, for example, showing the name of the game image, the tribe, attack, defense and the like. (See Present Specification, paragraph [0050] and Figure 8).

In the second instance, the Yamada reference fails to disclose "means for displaying provisionally selected text data . . . for displaying said text data corresponding to said provisionally selected language switched from one of said game

image which has been displayed on said background of said language selection picture . . .," as required by claims 1 and 5.

The Yamada reference simply does not disclose the display of text data associated with the game image, where the game image and the text data are displayed in the background of the "on-screen display." Rather, in the Yamada system, the text (e.g., "volume") is displayed directly on the CRT, without a "language selection picture," and without the image *and* text in the background. (See the Yamada reference, pg. 10, lines 1-3, 8-10 and FIGS. 5, 6.) With the claimed invention, a "language selection picture" FL is superimposed over the game image PC1 so that the background of the language selection picture is the game image. (See Present Specification, paragraph [0055] and Fig. 6.) Text (e.g., WD1, WD2, WD3, WD4) corresponding to the game image PC1 is displayed in the background of the language selection picture. (See *id.*)

Nor does the Yamada reference *inherently* disclose "means for displaying provisionally selected text data . . . said text data corresponding to said game image displayed with said language selection picture . . .," or "means for displaying provisionally selected text data . . . for displaying said text data corresponding to said provisionally selected language switched from one of said game image which has been displayed on said background of said language selection picture . . .," as required by claims 1 and 5.

Applicants note that the Court of Appeals for the Federal Circuit has stated that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993). Further, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' See *In re Robertson*, 169 F.3d 743, 754 (Fed. Cir. 1999).

Additionally, "[i]n relying on a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." See *ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

With applicants' claimed invention, the game image which the player has played just before the player selects the language can be located in the background of the language selection picture, and the text data which has been displayed on the game image can be switched among a plurality of languages so as to correspond to the player's provisional selection state, so that the player can easily select the language the player wishes from the text on the game image which the player has played (i.e., not the representation of language, such as the words "English", "Japanese" or "Chinese") and can set the language as the one to be used in the game. Such a feature is not disclosed in the Yamada reference.

Therefore, because the Yamada reference fails to disclose, either expressly or inherently, all of the limitations of independent claims 1 and 5, applicants request that the 35 U.S.C. § 102(b) rejections of these claims be withdrawn. With respect to claims 2 and 3, which depend from independent claim 1 and recite additional features of the invention, applicants request that the 35 U.S.C. § 102(b) rejections of these claims be withdrawn for the same reasons stated for claim 1.

The claims as amended are believed to be in condition for allowance.
Reconsideration and allowance are requested.

A fee of \$395.00 is believed due with this submission, accompanying the concurrently filed Request for Continued Examination. The Commissioner is hereby authorized to charge this fee, as well as any other required fees, to deposit account number 04-1679.

Respectfully submitted,



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